Appl. No. 10/763,642
Reply dated June 25, 2006
Reply to Office Action mailed March 9, 2006

## REMARKS

The present application and its claims are directed to a system and method for collection and conversion of document sets and related metadata to a plurality of document/metadata subsets.

## PRIOR ART REJECTIONS

In response to the Examiner's rejection of Claims 1-4, 13-16 and 25-28 under 35 U.S.C. 103 as being unpatentable over US Published Patent Application No. 2004/0205462 to Levine (hereafter "Levine"), claims 5, 8-10, 17, 20-22, 29 and 32-34 under 35 USC 103 as being unpatentable over Levine in view of US Published Patent Application No. 2003/0163784 to Daniel et al. (hereafter "Daniel"), claims 6-7, 18-19 and 30-31 under 35 USC 103 as being unpatentable over Levine in view of US Published Patent Application No. 2002/0035697 to McCurdy et al. (hereafter "McCurdy") and claims 11-12, 23-24 and 35-36 under 35 USC 103 as being unpatentable over Levine in view of US Published Patent Application No. 2004/0201633 to Barsness (hereafter "Barsness"), Applicant traverses the rejections because the claims are not unpatentable over Levine or the combination of prior art cited by the examiner for the reasons set forth below and therefore the claims are allowable.

Claims 1, 13 and 25

These claims are improperly rejected as being unpatentable over Levine because the examiner has not established a prima facie case of obviousness. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). For this rejection, the examiner cannot establish that the prior art (Levine) teaches or suggests all of the claim limitations nor that there is any motivation or suggestion to modify Levine in the manner argued by the examiner. For these reasons, the rejection of claims 1, 13 and 25 should be withdrawn. In addition, the claims (claims 2-12, 14-24 and 26-36) that depend from these

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independent claims are allowable over the prior art for at least the same reason as the independent claims.

### Levine Does Not Teach or Suggest each Claim Limitation

Levine does not teach each all of the claims limitations (See page 3 of the Office action) nor does Levine suggest all of the claims limitations. In the office action, the examiner argued that, "However, it would have been obvious to one of ordinary skill in the art at the time of invention for some sort of validation to have occurred by virtue of transfer protocols (http, ftp) that performs checks to make certain that data transfer was complete and successful and that were available at the time of invention." *See Office action, page 3.* Thus, the examiner argues that a transfer protocol that verifies the complete data transfer was known. However, the claims recite "a module that validates the input file" or "validating the input file." Even if a transfer protocol that verifies the complete transfer is known, that fact does not suggest validating the input file (e.g., checking the format of the input file) as set forth in claims.

Furthermore, Levine does not teach or suggest "a conversion module that generates two or more editions of a work having one or more formats, the two or more editions of the work being generated based on the intermediate format file and the work metadata" or the similar element in the other independent claims. The examiner argues that "... once a request is made for a book, the stored, solution-independent, intermediate format files are converted depending on whether a bound book or an electronic book is requested (See Figs. 2,3; workflow paths for bound and e-book)." *See Office action, page 3.* However, Levine discloses that a single bound book or e-book copy is generated for each request based on book files. *See Levine. paragraphs 0020 and 0022.* In contrast, the claimed invention generates two or more editions of a work having different formats and Levine does not disclose or suggest that two or more editions of a work having different formats are generated.

### No Motivation/Suggestion to Modify Levine

The examiner has not established that there is a suggestion or motivation to modify Levine as suggested by the examiner. The examiner has argued, "However, it would have been obvious to one of ordinary skill in the art at the time of invention for some sort of validation to have occurred by virtue of transfer protocols (http, ftp) that performs checks to make certain that data transfer was

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complete and successful and that were available at the time of invention." *See Office action, page 3.*
However, this argument does not set forth any evidence of the suggestion or motivation to modify
Levine in the manner suggested by the examiner nor where that suggestion or motivation is found.
In fact, Levine does not in any way suggest that input file validation is necessary. In addition, the
allegedly known transfer protocol cited by the examiner (see argument above) does not suggest nor
motivate someone to modify Levine in the manner argued by the examiner. Therefore, the
examiner has not established the suggestion or motivation to modify Levine.

Therefore, the rejections of claims 1, 13 and 25 (as well as the dependent claims) cannot be
maintained since the examiner has not established a prima facie case of obviousness of these claims
for the reasons set forth above.

Claims 2, 14 and 26

These claims are improperly rejected as being unpatentable over Levine because the
examiner has not established a prima facie case of obviousness. In particular, Levine does not teach
or suggest "a storage portion that stores a piece of form metadata associated with the intermediate
format file, the form metadata specifying a form of an edition of the work" as recited in these
claims. The examiner cited steps 204 and 206 of Levine to support his rejection of these claims.
These steps in Levine acquire the solution-independent master book files from memory and
acquiring/generating the appropriate book production information. *See Levine, paragraph 0019.*
The book production information in Levine is not specified. Levine does discloses book
identification information that includes title, author, publisher, ISBN and publication date. *See
Levine, paragraph 0016.* However, Levine does not disclose the claimed form metadata
specifying a form of an edition of the work. In addition, since Levine contemplates generating a
single bound book or ebook (see above), Levine also does not suggest the claimed form metadata
specifying a form of an edition of the work.

Claims 3-4, 15-16 and 27-28

These claims are improperly rejected as being unpatentable over Levine because the
examiner has not established a prima facie case of obviousness. In particular, Levine does not teach
or suggest "a distribution module that distributes the two or more editions of the work" as set
forth in claims 3, 15 and 27 or "wherein the distribution module further comprising a plurality of

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distribution channels wherein each distribution channel receives a different edition of the work"
as set forth in claims 4, 16 and 28. As above, Levine describes a system that generates a single
bound book or ebook for a user as set forth above. Therefore, Levine does not teach the claimed
distribution module for the two or more editions of the work nor the plurality of distribution
channels wherein each distribution channel receives a different edition of the work. In addition,
since Levine generates a single bound book or ebook for each request, Levine also does not
suggest these features. Therefore, claims 3-4, 15- 16 and 27-28 are allowable over Levine.

### Claims 10, 22, 34

The examiner has rejected claims 10, 22 and 34 as being unpatentable over Levine and
Daniel. These claims however are not unpatentable over Levine and Daniel because every
limitation of these claims are not taught or suggested by Levine and/or Daniel. The examiner
has argued that, while Levine does not teach this element, Daniel teaches this element. *See
Office action at pages 5-6.* However, contrary to the examiner's assertion, Daniel does not teach
this element. In Daniel, as explained by the examiner, a subset of the e-content or e-learning
objects (content) can be assembled into a publication. In contrast, claim 10 recites "wherein an
edition of the work further comprises an edition containing a subset of the work metadata
associated with the intermediate format file" so that it is the subset of the work metadata (not the
content as with Daniel) that is part of the edition of the work. Therefore, the combination of
Levine and Daniel does not teach each limitation of these claims and the rejection of these claims
should be withdrawn.

### CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-36 are allowable over the
prior art cited by the Examiner and early allowance of these claims and the application is
respectfully requested.

The Examiner is invited to call Applicant's attorney at the number below in order to speed
the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any
overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

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DLA PIPER RUDNICK GRAY CARY US LLP

Dated: __7 – 10 – 2006__     By _____

Timothy W. Lohse
Reg. No. 35,255
Attorney for Applicant


DLA PIPER RUDNICK GRAY CARY US LLP
2000 University Avenue
East Palo Alto, CA 94303
Telephone: (650) 833-2055

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